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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, A. D. 1943.

No. 204

MEAD JOHNSON & COMPANY,
Petitioner,

vs.

HILLMAN'S, INC.,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT, AND BRIEF IN SUPPORT THEREOF.

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THE TWENTIETH CENTURY PRESS, INC., CHICAGO

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PETITION FOR WRIT OF CERTIORARI.

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Now comes Mead Johnson & Company, petitioner here and plaintiff-appellant below, and respectfully petitions this Honorable Court to grant a writ of Certiorari to the Circuit Court of Appeals for the Seventh Circuit to review a judgment of that Court affirming a decree of the District Court of the United States for the Northern District of Illinois, Eastern Division.

A certified transcript of the record in the case, including the proceedings in the Seventh Circuit Court of Appeals, is furnished herewith.

Summary and Short Statement of the Matter Involved.

This action was brought for infringement of Johnson et al. Patent No. 1,990,329 on a dry, pre-cooked cereal product suitable for infant feeding. The District Court found the patent invalid and dismissed the complaint for

want of equity. The Circuit Court of Appeals for the Seventh Circuit affirmed this decree.

This petition is directed to a review of the decision of the Circuit Court of Appeals for the Seventh Circuit.

Jurisdiction.

This is a suit arising under the patent laws of the United States, Judicial Code, Section 24 (7) (28 U. S. C. A. 41 (7)).

The jurisdiction of this Court is invoked under Section 24 (a) of the judicial code, as amended by the act of February 13, 1925 (28 U. S. C. A. 347).

The date of the decree which petitioner asks to have reviewed is May 21, 1943 (Rec. 484). The petition for rehearing was denied July 6, 1943 (Rec. 487).

The Questions Presented.

1. Whether the Circuit Court of Appeals for the Seventh Circuit, in disregarding an unobvious advantage because it was not functionally described in the claims, has adopted a rule of law inconsistent with the law as laid down by this Court, and in direct conflict with the rule of law followed by certain other Circuit Courts of Appeal.

2. Whether, giving proper consideration to the unobvious advantage disregarded by the Circuit Court of Appeals for the Seventh Circuit, Johnson et al. Patent 1,990,329 in suit is valid.

Reasons Relied on for Allowance of Writ.

The discretionary power of this Court to grant a Writ of Certiorari is invoked upon the following grounds:

1. That the Circuit Court of Appeals for the Seventh Circuit, in its decision, set forth and followed a rule of law

in conflict with the law as enunciated by this Court.[1]

2. That the Circuit Court of Appeals for the Seventh Circuit, in its decision, enunciated a rule of law in direct conflict with the law as followed by other circuits, and more particularly the First,[2] Third,[3] and Sixth[4] Circuits, so that there is now a conflict of law between the Seventh Circuit and said First, Third, and Sixth Circuits.

3. That the Circuit Court of Appeals for the Seventh Circuit, by reason of giving no effect to an important and unobvious advantage of the product as an infant's food, because of such court's erroneous rule of law that an advantage is to be disregarded unless described in the claims, wrongly held the Johnson *et al.* patent in suit invalid when said patent represents a great advance in the art of infant feeding and, in fact and law, is valid.

Wherefore, it is respectfully submitted that this petition for a Writ of Certiorari to the Circuit Court of Appeals for the Seventh Circuit should be granted.

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[1] *Diamond Rubber Co.* v. *Consolidated Tire Co.* (1911), 220 U. S. 428, 436, 437.

[2] *I. T. S. Rubber Co.* v. *Panther Rubber Mfg. Co.* (C. C. A. 1, 1919), 260 F. 934, 937.

[3] *Gear* v. *Fairmount Electric Co.* (C. C. A. 3, 1916), 231 F. 728, 732; *Mead-Morrison Mfg. Co.* v. *Exeter Mach. Works* (C. C. A. 3, 1915), 225 F. 489, 496.

[4] *Jackson Fence Co.* v. *Peerless Wire Fence Co.* (C. C. A. 6, 1915), 228 F. 691, 696.

Summary of Argument.

In its opinion in this case, the Seventh Circuit Court of Appeals has laid down the rule of law that an advantage not described in the claims of a patent is to be disregarded. This is in conflict with the law as announced by this Court and as explicitly stated in at least three of the other circuits..... 9

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Respondent.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

The Opinions of the Courts Below.

The opinion of the District Court of the United States for the Northern District of Illinois, Eastern Division, was filed September 4, 1942. It was not officially reported, but may be found in 55 U. S. P. Q. 6, and appears in the record at page 426 *et seq.*

The opinion of the Circuit Court of Appeals for the Seventh Circuit was filed May 21, 1943. It is reported in Fed. (2d) , and in 57 U. S. P. Q. 448; and it appears in the record at page 478, *et seq.*

Jurisdiction.

(Note corresponding section in the Petition for Writ of Certiorari, *supra,* Page 2.)

Statement of the Case.

Johnson *et al.* devised a new food product for infants, a dry, pre-cooked cereal in such form and having such characteristics that, when mixed with milk or water of any temperature, it instantly reconstitutes into a true mush or porridge having the taste, appearance, and characteristics of a cereal which has been thoroughly cooked in a double boiler for a long period, and with the ability to hold in stable suspension a very high ratio of liquid. Patent No. 1,990,329[5] thereon issued to Mead Johnson & Company, petitioner here, containing claims to such product and to one process for making it. Only the two product claims[6] are in issue here. Mead Johnson & Company manufactures and sells the patented product under the trade-mark "Pablum."

This suit for infringement was brought against Hillman's, Inc., a retail store in Chicago, Illinois, by reason of its sale of Gerber's Cereal Food and Gerber's Strained Oatmeal, dry, pre-cooked infant's cereals manufactured by Gerber Products Company, of Fremont, Michigan. The accused cereals, like petitioner's Pablum, are small, shiny, fragile, porous flakes having all of the characteristics set forth in the product claims in suit. As a result, they have the patented product's ability to instantly reconstitute into a true mush upon the addition of liquid of any temperature, and to hold a high ratio of liquid in stable suspension.

In addition to its great convenience of preparation and high digestibility, the patented product has a very impor-

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[5] Rec. 443.

[6] Claims 5 and 6 of *Johnson et al.* Patent 1,990,329, Rec. 445.

tant advantage as an infant's food in that it is capable of absorbing and holding in a stable suspension 12 or more times[7] its own weight of liquid. This is to be contrasted with the fact that cereal foods such as Zwieback and Holland Rusk, which may be crumbled with milk or water to make a soft food for babies, will hold only three and five times[8] their weight of liquid in stable suspension, respectively. The physical characteristics of the patented cereal flakes is of importance in this regard since, when the patented product is ground to a flour, it will only hold in stable suspension about 8 times its own weight in liquid; i.e., these particular patented flakes unexpectedly absorb a great deal more liquid than the same product in a finely ground state.

This unexpected and unobvious ability to hold in stable suspension a large quantity of liquid is particularly important in feeding infants troubled with a common difficulty known as pylora spasm. Babies having this condition vomit up free liquid, and are unable to retain and assimilate it, but they can and do retain suspensions or mushes in their stomachs, and absorb both the food and the liquid therefrom.[9]

The high ratio of liquid absorption is important because a very young infant needs a high proportion of liquid (an 11 pound baby should receive 32 ounces of liquid per day). Since 2½ ounces of the dry patented product will hold 32 ounces of liquid in stable suspension, a baby troubled with pylora spasm can retain its necessary daily quantity of liquid in a mush formed with that amount of cereal, a large amount for an infant only a few months old,[10] but within its digestive capacity. To provide a stable suspension of the requisite amount of liquid by the use of

7 Rec. 332.
8 Rec. 332.
9 Rec. 297.
10 Rec. 296.

Zwieback, for example, would require 10 or 11 ounces, an impossible quantity for a two or three months old infant.

The claims in suit clearly and definitely define (in terms of some 7 or 8 physical characteristics) the dry, precooked cereal which has this unexpected and highly important advantage as an infant's food. This advantage or function, however, is not stated in the claims.

Specification of Errors.

The errors which petitioner will urge, if the Writ of Certiorari is issued, are that the Circuit Court of Appeals for the Seventh Circuit erred:

(1) In disregarding the advantage, in an infant's food, of a very high liquid absorption ratio, and the unobviousness of the flake product having a higher liquid absorption than a flour made from such product, on the basis of the erroneous rule of law that an advantage of a product not stated in the claims is to be disregarded.

(2) In giving anticipatory effect to an undescribed intermediate product in a prior art process patent, the process of which was never followed in the United States and lay unused for more than a quarter of a century.

(3) In failing to give effect to the long felt want for a product of the kind described and claimed in the Johnson *et al.* patent, and the immediate and widespread public acceptance of the patented product.

(4) In holding the Johnson *et al.* patent in suit non-inventive over the prior art.

Argument.

The Seventh Circuit Court of Appeals has erred here in an important proposition of patent law. This Honorable Court, in the Diamond Rubber case,[11] gave effect and weight to an unobvious and highly important advantage not described in the specification or claims of the patent in suit, and held the patent valid.

Now the Seventh Circuit Court of Appeals, in its opinion in this case, has announced the opposite rule of law, that an advantage not mentioned in the claims is to be disregarded. This is in conflict with the Diamond Rubber case; and presents a conflict between the law as now laid down by the Seventh Circuit Court of Appeals and by other Courts of Appeal, as the First,[12] Third[13] and Sixth[14].

One of the very important advantages as an infant's food, stressed by plaintiff, was the very high ratio of liquid absorption of the patented cereal product; and the unobviousness that it would have such a high ratio at all, and particularly that it would have a ratio nearly double that of a flour made from the same product.

The Court of Appeals recognized this to be an important factor in an infant's food, saying:[15]

> "From the record we learn that ease and rapidity in the digestion of a cereal food and the ability of the food to hold a large ratio of water in suspension are important factors where the food does not stay in the digestive tract as long as normally because of some upset condition; * * *"

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11 *Diamond Rubber Co.* v. *Consolidated Tire Co.* (1911), 220 U. S. 428, 436, 437.

12 *I. T. S. Rubber Co.* v. *Panther Rubber Mfg. Co.* (C. C. A. 1, 1919), 260 F. 934, 937.

13 *Gear* v. *Fairmount Electric Co.* (C. C. A. 3, 1916), 231 F. 728, 732; *Mead-Morrison Mfg. Co.* v. *Exeter Mach. Works* (C. C. A. 3, 1915), 225 F. 489, 496.

14 *Jackson Fence Co.* v. *Peerless Wire Fence Co.* (C. C. A. 6, 1915), 228 F. 691, 696.

15 Rec. 479.

Yet the Court of Appeals completely disregarded and gave no weight to this important and unexpected advantage because *it was not functionally stated in the claims.* Defendant, in its brief and argument in the Court of Appeals, urged the proposition that an advantage not set forth in the claims must be ignored in determining the question of invention; and the Seventh Circuit Court of Appeals erroneously accepted this proposition of law, its opinion disposing of this advantage by saying:[16]

> "Plaintiff also contends that an unobvious advantage of 'Pablum' is its ability to hold a very high ratio of liquid in suspension, about twelve times its own weight in liquid. *It will be enough to say that the claims make no mention of this property.*"

The law is clear that claims define a composition properly by defining its *physical characteristics* (as is done here). *It is enough that a new and important advantage results from such combination of characteristics. Such advantage need not be stated in the claims. All that is necessary is that the claims define a composition which is new and different from anything in the prior art, and that the composition defined has the advantage relied on as an improvement in the art.*

In the case of *Diamond Rubber Co.* v. *Consolidated Rubber Co.* (1911), 200 U. S. 428, 55 L. Ed. 527, the opinion of Mr. Justice McKenna specifically recognized the fact that the tipping capacity of the Grant patented tire was its important advance over the prior art, although this advantage was not mentioned in the specification or claims of the patent. This Court upheld the validity of the Grant patent, giving weight to the tipping function, so that it is settled law that an advantage need not be mentioned in the specification or claims of a patent as long as the structure or

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16 Rec. ....

composition is properly defined, and has the desired advantage. Mr. Justice McKenna said (220 U. S. 436, 437):

> "He must, indeed, make such disclosure and description of his invention that it may be put into practice. In this he must be clear. * * * This satisfies the law, which only requires as a condition of its protection that the world be given something new and that the world be taught how to use it. * * *
>
> To take from him the advantage of it upon nice speculation as to whether it was an ignorant guess or confident knowledge and adaptation might do him great injustice. His success is his title to consideration."

This rule has been followed, and the law in this regard expressly stated, in cases in the First, Third and Sixth Circuits.

The rule of law has been stated by Judge Bingham for the First Circuit Court of Appeals in *I. T. S. Rubber Co.* v. *Panther Rubber Mfg. Co.* (C. C. A. 1, 1919), 260 F. 934, 937, where he said:

> "The patent is for a structure, and the plaintiff is entitled to the benefit of all the advantages which it possesses over the prior structures intended to accomplish a similar purpose; and the patentee's failure to state in the patent the new mode of operation which his device in fact contains, and which produces a new and beneficial result, does not prohibit the court from taking these merits into consideration in determining the scope of the invention or the validity of the patent."

The rule has been set forth in the Third Circuit Court of Appeals in at least two cases, *Mead-Morrison Mfg. Co.* v. *Exeter Mach. Works*, (C. C. A. 3, 1915), 225 F. 489, 496; and *Gear* v. *Fairmount Electric Co.*, (C. C. A. 3, 1916), 231 F. 728, 732, where Justice McPherson said:

"It is true that the specification and the claims do not refer to all the advantages that seem to accompany the device, but this is not material. If a specification or a claim be sufficient in itself, it need not be all-embracing. It will still be good as far as it goes; and, if it does not go as far as it might have gone, that is the inventor's affair. The evidence before us seems to prove satisfactorily that one advantage of the Williams Device is the facility it affords for narrowing the area of search whenever 'trouble' occurs in an electric circuit; and another advantage is the more effective protection it affords to men busy with repair or inspection. It is readily installed, is harmless if accidentally touched, and can be easily and safely connected and disconnected without the use of tools. *The inventor is entitled to reap the benefits of these advantages, although he may not have mentioned them, or even known of them, provided they come to light in operating the device actually described and claimed.*"

The correct rule is being followed in the Sixth Circuit Court of Appeals, as evidenced by the case of *Jackson Fence Co.* v. *Peerless Wire Fence Co.,* (C. C. A. 6, 1915), 228 F. 691, 696, where Judge Denison said:

"We do not overlook the fact that the peculiar utility which his invention is now seen to possess, and which we have described, is not stated in so many words in his specification; but there are two sufficient reasons why this omission is not important. The first is that if he had undertaken to state the practical, commercial benefits, and had omitted what afterwards proved to be the chief one, he would, nevertheless, be entitled to have his patent construed with reference to that unspoken advantage, since the patentee is entitled to the benefit of every function within the scope of the claims and actually possessed by his mechanism, even if he does not know of it at the time of patenting. *Morgan Co.* v. *Alliance Co.,* (C .C. A. 6) 176 Fed. 100, 107, 100 C. C. A. 30; *Kellogg* v. *Deane,* (C. C. A. 6), 182 Fed. 991, 998, 105 C. C. A. 545. The second reason is that

this patent does not undertake to name any practical advantages or benefits, save, in general terms, 'to simplify and improve upon the construction and apparatus of this class, whereby to enhance the practicability and commercial value thereof'; and *no obligation rests upon the patentee to convert his specification into a trade circular. Its proper office is to describe the structure, and in so far as the patentee claims commercial benefits and advantages, he is giving unnecessary information.*"

The holding of the Seventh Circuit Court of Appeals, in this case, is therefore directly opposite to the holding by this Honorable Court in *Diamond Rubber Co.* v. *Consolidated Rubber Tire Co.* (1911), 220 U. S. 428; and, unless certiorari is granted, the law in the Seventh Circuit will hereafter, in this regard, be in conflict with the law as laid down by this Court and as followed in the First, Third and Sixth Circuits.

The claims of the Johnson *et al.* patent do not attempt to define over the prior art by functional statements of advantages, and properly so. The claims define over the prior art by setting forth *definite physical characteristics,* such as that the dry pre-cooked cereal flakes are very thin and fragile, of porous construction throughout, characterized by dextrinization, etc. The cereal product *having these definite physical characteristics has the very important advantage,* for infant feeding, of an unexpectedly high liquid absorption ratio.

This advantage was completely disregarded by the Seventh Circuit Court of Appeals, on the basis of its erroneous proposition of law that an advantage not set forth in the claims is not to be given effect on the question of the presence of invention.

Conclusion.

We are here concerned with a really meritorious invention, one which not only constitutes a real advance in the art but which has been a boon (a very real blessing) to millions of mothers. It not only filled a long-felt want, a real need, but it received the praise of commercial success, petitioner's sales of Pablum rising at the rate of a million pounds a year, and it was immediately put into wide use by competitors of petitioner as soon as the merits of the Johnson *et al.* invention became known to the public.

A patent of this kind, covering a very real invention, should not be struck down merely because the lower courts have applied a rule of law which is inconsistent, not only with the law as announced by this court, but with the decisions of other courts of appeal. The public and industry generally are entitled to have this case decided in accordance with the well settled principles of law.

The action of the Seventh Circuit Court of Appeals in disregarding the advantage of an unexpectedly high water absorption ratio in the patented product, because that advantage was not described in the claims, is erroneous; and certiorari should be granted to correct this error.

Respectfully,

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July 24, 1943.

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BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

To the Honorable Chief Justice and the Associate Justices of the Supreme Court of the United States:

This brief is submitted in behalf of the Respondent here, appellee below in the United States Court of Appeals for the Seventh Circuit, and defendant in the District Court of

the United States for the Northern District of Illinois, Eastern Division.

The Opinions of the Courts Below

This suit was brought by Petitioner for infringement of Johnson, *et al.*, United States Patent No. 1,990,329. The District Court held the claims in issue to be invalid and dismissed the complaint, the opinion of the District Court appearing in the Record at page 426 et seq. and reported in 55 U. S. P. Q., 6. The Circuit Court of Appeals for the Seventh Circuit affirmed the judgment of the District Court, the decision appearing in the Record at page 478 et seq. and also reported in 135 Fed (2d) 955, and 57 U. S. P. Q., 448. Petitioner herein filed in the Seventh Circuit Court of Appeals a petition for rehearing, which was denied by that court without opinion on July 6, 1943 (Rec. 487).

Jurisdiction

There is no question of a conflict between the Circuits as to the validity or scope of the patent involved in this suit, and the primary reason advanced for the issuance of a Writ of Certiorari herein is that the decision of the Seventh Circuit Court of Appeals enunciates a rule of law at variance with the law as laid down by this Court and by other Circuits.

Statement of the Case

The two claims here in suit are product claims, numbers 5 and 6 of the Johnson et al patent (Rec. 445). Those claims, stripped of their technical verbiage, cover essentially a precooked, dry cereal product which, upon the addition of a liquid, will form a mush or porridge. One of the claims,

number 5, recites that the product is "suitable for infant feeding".

A generally similar product was old in the art long prior to the patent in suit as evidenced by the well known "Zwieback" and "Holland Rusk" of common knowledge, the manufacturers of which suggested that a mush for infant feeding could be formed by crumbling such products and adding thereto a liquid. Both the lower Courts therefore held that the claims in suit are invalid because the product defined thereby did not involve a patentable invention over the general knowledge in the cereal art (Rec. 430, 483).

The Petitioner asserts for its patented product certain properties which are not present to the same degree in Zwieback and Holland Rusk, and which properties are alleged to arise out of the particular method of manufacturing the patented product.

However, two of the prior art patents, Braunbeck U. S. Patent No. 1, 011, 730 (Rec. 462-464) and Braunbeck British Patent No. 9528 of 1906 (Rec. 465-467), disclose a process for treating grains in substantially the same way as the process of the patent in suit, and the District Court and the Seventh Circuit Court of Appeals so held (Rec. 430, 480). These Courts consequently held that the Braunbeck product was the same in all patentable respects to the product defined by the claims here in suit, and that those claims are therefore invalid (Rec. 430, 483).

The principal reason advanced for the issuance of a Writ of Certiorari herein is that the Seventh Circuit Court of Appeals in its decision laid down and followed an erroneous rule of law, in conflict with the law as enunciated by this Court and by the Circuit Court of Appeals for the First, Third and Sixth Circuits. Specifically, the Petitioner contends that the Circuit Court of Appeals in the present case held that an unobvious advantage of a patented product

may be disregarded unless such advantage is recited in the patent claims.

The Respondent's position is that there is no conflict between the decision of the Circuit Court of Appeals herein and the law as enunciated by this Court and by the other Circuits, *because the Seventh Circuit Court of Appeals did not enunciate any such rule of law as the Petitioner seeks to attribute to that Court's opinion.**

Summary of Argument

1. The Seventh Circuit Court of Appeals did not hold that an advantage not described in the claims of a patent is to be disregarded. On the contrary, the Court explicitly held that even if the alleged unobvious advantage asserted for the patented product had been recited in the claims in suit, patentability could not be predicated thereon inasmuch as it would be merely a "functional statement".
2. In reaching its decision that the claims in suit are invalid, the Seventh Circuit Court of Appeals gave due consideration to the alleged unobvious advantage asserted for the patented product—its ability to hold a high ratio of liquid in suspension (*i. e.* its ability to absorb a large quantity of water). In evaluating the anticipatory effect of the prior art Braunbeck patents, the Court found that those pat-

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*This renders superfluous any discussion of the decisions of this Court and of the Circuit Court of Appeals of the First, Third and Sixth Circuits with which Petitioner contends (Petitioner's Brief, page 9) the decision herein of the Circuit Court of Appeals conflicts. However, it is to be noted that in each of the cases cited by the Petitioner the claims there involved defined a **novel** structure, not found in the prior art. Such is not the fact in the instant case, where the claims in suit read squarely on the Braunbeck product.

ents disclose and teach the public the very advantage in a similar product which Petitioner urges is now "unobvious" in the patented product.

3. The Seventh Circuit Court of Appeals, upon sound reasoning, properly affirmed the District Court's findings that the claims in issue are invalid (a) because of anticipation by the Braunbeck British and American patents and (b) because of lack of invention over the general prior art.

Argument

1. The Circuit Court of Appeals for the Seventh Circuit Did NOT Hold That an Unobvious Advantage Asserted for a Patented Product May be Ignored If the Claims Do Not Functionally Recite That Advantage.

To support its assertion that the Seventh Circuit Court of Appeals in its opinion in this case erroneously stated an important proposition of patent law, in conflict with the law as enunciated by this Court and by other Circuits, the Petitioner unroots from one paragraph of the opinion a single sentence, adds it to a preceding paragraph, and thereby imputes to the transplanted sentence a meaning different from that intended by the Court. The sentence relied upon by the Petitioner appears in italics in the following quotation appearing at page 10 of the Petitioner's brief:

> "Plaintiff also contends that an unobvious advantage of 'Pablum'* is its ability to hold a very high ratio of liquid in suspension, about twelve times its own weight in liquid. *It will be enough to say that the claims make no mention of this property.*"

*Product manufactured by Petitioner, and which is an embodiment of the claims in suit.

Relying upon this sentence, Petitioner asserts that the Court disregarded an unexpected advantage "because it was not functionally stated in the claims" (Petitioner's brief p. 10). This is not correct as readily appears when the sentence is read in its proper relation to the context of the paragraph in which it actually appears. The real language of the Court was (Rec. 481):

> "Plaintiff also contends that an unobvious advantage of 'Pablum' is its ability to hold a very high ratio of liquid in suspension, about twelve times its own weight in liquid.
>
> "It will be enough to say that the claims make no mention of this property. All that the Johnson patent says about fluid absorptive properties of the product is that the material has 'extremely quick' fluid absorptive properties. Even if the claims did recite that the product was characterized by its ability to hold a very high ratio of liquid, patentability could not be predicated theron, since the ability to absorb a large amount of water is merely a broad statement of an attribute or function of the product, and the rule is that functional statements cannot be availed of to define over the prior art. *General Electric Co. v. Wabash Applicance Corp.,* 304 U. S. 364."

It is clear from the entire foregoing quotation, and from the context of the opinion as a whole, that the Court did not enunciate as a rule of law that an alleged unobvious advantage of a patented product is to be disregarded "because it was not functionally stated in the claims", or, stated conversely, that an unobvious advantage must be "functionally stated in the claims" before a Court can consider such advantage. Indeed, in the last sentence of the quotation, the Court explicitly stated that, even if such a functional statement had been included in the claims, that

statement would have been of no significance in determining the validity of the claims.

2. The Circuit Court of Appeals Did Consider the Alleged Unobvious Advantage of the High Ratio of Liquid Absorption Asserted for the Patented Product.

Further evidence that the decision of the Circuit Court of Appeals does not stand for the proposition that an unobvious advantage must be recited in the claims is to be found in the fact that that Court did consider the alleged high ratio of liquid absorption asserted for the patented product.

Throughout the proceedings in the courts below, the Petitioner's principal argument for the validity of its patent here in suit was its alleged unobvious advantage residing in the absorption of a large quantity of liquid by the patented product. Both the District Court and the Circuit Court of Appeals for the Seventh Circuit obviously considered this argument, and the Circuit Court of Appeals in its opinion lists this argument specifically (Rec. 481) when it said:

> "According to Johnson et al they were the first to originate and develop a process which produced a mush which is lump-free, *holds a high ratio of liquid in suspension,* is readily digestible and which can be instantly prepared for the baby." (Italics supplied.)

The Court then immediately, in the next sentence, states the problem with which it is confronted:

> "The question we are called upon to solve is whether the prior patents disclose such characteristics and advantages and taught the art what Johnson teaches, thus

determining whether what Johnson accomplished amounts to invention."

And the Circuit Court of Appeals specifically found that the prior art *did* disclose a cereal product which "holds a high ratio of liquid in suspension", In its opinion (Rec. 480), the Court discusses the United States and British Braunbeck patents and therein points out that their thoroughly cooked and dried cereal flour "immediately absorbs a great quantity of water when brought into contact therewith". This finding not only answers the Petitioner's assertion herein that the Circuit Court of Appeals did not consider the alleged unobvious advantage, but also completely disposes of the Petitioner's entire argument with respect to that advantage—we have here an explicit holding by that Court that *the prior art discloses the very advantage which the Petitioner urges is now "unobvious."*

3. The Seventh Circuit Court of Appeals, Upon Sound Reasoning, Properly Affirmed the District Court's Finding That the Claims in Issue are Invalid.

The Petitioner urges, as a supplementary ground for the issuance of a Writ of Certiorari, that the Seventh Circuit Court of Appeals erroneously held the claims in suit invalid "when said patent represents a great advance in the art of infant feeding, and, in fact and law, is valid" (Petition, page 3). A brief review of that Court's opinion is therefore necessary, in order, to show the manifest soundness of its holding that the claims are invalid.

With reference to the anticipatory effect of the prior Braunbeck Patents, the Court of Appeals summarized the disclosure of those patents as follows (Rec. 480):

"Those patents, British Patent No. 9528 issued October 11, 1906, and United States Patent No. 1,011,730

issued December 12, 1911, disclose and describe a thoroughly cooked and dried flour (cereal product) produced by crushing the grain, the product leaving the rollers in the form of disintegrated flakes which are then reduced by a milling process to flour which swells and immediately absorbs a great quantity of water when brought into contact therewith."

The Petitioner admits (Rec. 480) that the product leaving the rollers in the Braunbeck process is the same as the patented product here in suit, but has contended throughout that this material from the Braunbeck rolls does not anticipate the claims in issue because it is only an "intermediate" product, is unappreciated, and that the Braunbeck Patents do not teach the use of the material as an infants' food nor its advantages as such a food (primarily its "high ratio of liquid absorption" discussed *supra*).

The Petitioner cited certain decisions in support of this contention. The Seventh Circuit Court of Appeals distinguished the facts of those cases from the facts here involved on the ground that the intermediate products in those cases were unknown to, and unappreciated by, the patentees and the public, whereas such was not the fact in the present case. After pointing out the manner in which Braunbeck disclosed the nature of his intermediate product, the Court concluded (Rec. 483):

"As we have already noted, the Johnson product is the same as the Braunbeck drum product, and since Braunbeck clearly and sufficiently described the essential characteristics of his product, it seems to us that with the knowledge disclosed by Braunbeck, one skilled in the art had a guide or chart enabling him to appreciate and recognize the new use of the Braunbeck product. *Berlin Mills Co. v. Proctor & Gamble*, 254 U. S. 156."

The foregoing suffices to show that the decision of the

Seventh Circuit Court of Appeals is in complete accord with the conclusion of the District Court, which held (Rec. 430):

> "The process described in the Braunbeck patents is substantially the same as the process set forth in the Johnson patent, and the Braunbeck product, therefore, is necessarily the same as plaintiff's product * * * * * * * * * While the Braunbeck patents refer to grinding the product from the rolls to form a flour and the patent in suit does not call for grinding after drying, the products from the rolls of the British and United States Braunbeck patents, both before and after grinding, are, in the court's opinion, identical in all patentably significant respects to the defendant's and plaintiff's products, respectively, and both Braunbeck patents accordingly anticipate."

As previously stated, both of the lower courts also held the claims in suit to be invalid in view of the general knowledge of the art. As stated by the District Judge (Rec. 430):

> "Furthermore, disregarding the Braunbeck Patents, the Court is of the opinion that the patent in suit does not disclose invention over general knowledge of the art. The manufacturers of Zwieback and Holland Rusk recommend that their products may be crumbled or ground and mixed with milk or water to form a gruel or mush for infant feeding. Professor Anton J. Carlson, of the University of Chicago, testified that these two products are a fit infant's food and would be readily digestible by the normal infant. * * * * *

The Court of Appeals affirmed this holding of the District Court (Rec. 483) and cited in support thereof the case of *Cerealine Mfg. Co. v. Bates,* 101 Fed. 272, 281 (C. C. A. 7th, 1900), where it was said, "Growth of the art of cereal foods, unless something distinctively new *in specie* is contributed,

is the growth of common public thought, and, therefore, independently of the process * * * belongs to the public."

It is clear, therefore, that the Circuit Court of Appeals for the Seventh Circuit, upon sound reasoning, properly affirmed the findings of the District Court that the claims in issue were invalid because of the Braunbeck patents and because of the general knowledge in the cereal art.

Conclusion

There is nothing in this case to warrant the issuance of a Writ of Certiorari. In deciding this case the Seventh Circuit Court of Appeals followed the law as laid down by this Honorable Court, and there is no conflict between the decision below and that of any of the several Circuit Courts of Appeal.

The District Court in its memorandum opinion recites fully its reasons for holding the Johnson et al patent invalid. The review by the Seventh Circuit Court of Appeals was thorough and complete. All arguments here presented were before that Court, and it properly concluded that the District Court's decision was correct and should be affirmed.

The Petition for Writ of Certiorari should be denied.

Respectfully submitted,

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